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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,869	08/30/2001	Pascal Arnaud	212527US0	7528
22850	7590	11/18/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
YU, GINA C				
ART UNIT		PAPER NUMBER		
1611				
NOTIFICATION DATE		DELIVERY MODE		
11/18/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/941,869

Applicant(s)

ARNAUD, PASCAL

Examiner

GINA C. YU

Art Unit

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/18/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-27,31-42,44-51,53-58,60-78,81-95,101,102,105,106 and 109-112 is/are pending in the application.
- 4a) Of the above claim(s) 53-57,60 and 61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-27,31-42,44-51,58,62-78,81-95,101,102,105,106 and 109-112 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Final Drawing (PTO-640)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of amendment filed on amendment filed on July 18, 2008. Claim rejections as indicated in the previous Office action dated February 21, 2008 are hereby withdrawn in view of the amendment in part and applicant's remarks in part. New rejections are made to address the new claim limitation. Claims 2-27, 31-42, 44-51, 53-58, 60-78, 81-95, 101- 102, 105, 106, 109-112 are pending, of which claims 53-57, 60, and 61 have been withdrawn from consideration.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 5-10, 32-35, 37, 38, 39-42, 46, 48-51, 58, 83, 85-88, 91, 101, 111, 112 are rejected under 35 U.S.C. 102(b) as being anticipated by Mellul (US 5738841).

Mellul teaches a cosmetic eye shadow composition comprising 10 % octyldodecyl neopentanoate (non-volatile hydrocarbon oil, MW 382.67), 2 % of polydimethylsiloxane and silicone gum mixture (Q2 1403 from Dow Corning), and 40 % pigments, and 48 % talc (inert particulate). See example 7; instant claims 7-10, 83, 87, 91-94, 101. The reference teaches using octyldodecyl neopentanoate in 0.5-99 % by weight. See col. 2, lines 30 – 33; instant claims 32-35. The reference teaches that octyldodecyl neopentanoate is "an excellent agent for compatibilizing silicone-containing compounds with each other, has good thermal and chemical stability, and makes it possible to obtain compositions with much oilier texture on application than comparison with compositions of the prior art not containing it". See col. 2, lines 11 – 21. The

reference further teaches that the ester has dispersant properties with respect to powders, and makes it possible to make a homogeneous dispersion. See col. 2, lines 21 – 24. The reference also teaches using at least one silicone-containing compound such as polymethylsiloxanes, alkyltrimethicone, polyphenylmethylsiloxane, more specifically, phenyldimethicone and phenyltrimethicone; and silicones modified with aliphatic and/or aromatic groups, which optionally contain fluorine, or with functional groups such as hydroxyl, thiol and/or amine groups. See col. 2, lines 47- col. 3, line 5; see Example 3. See instant claims 105, 109, and 110.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2-4, 11-19, 21-27, 31, 36, 44, 45, 47, 62-72, 74-78, 81, 82, 84, 89, 90, 92-95, 102, 105, 106, 109, 110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mellul as applied to claims 5-10, 32-35, 37, 38, 39-42, 46, 48-51, 58, 83, 85-88, 91, 101, 111, 112 above, and further in view of Jacks et al. (US 5690918).

Mellul is relied upon as discussed above. The reference further teaches making lipsticks and also teaches using fillers together with pigments in the fatty phase, rendering claim 95 obvious. Discovering a workable weight amount of the fillers and non-volatile silicone component to make a stable composition would have been within the skill of the art.

Mellul fail to teach non-volatile hydrocarbon oil having the MW limitation of instant claims 2-4 and the dispersant of the instant claims 11-19, 21-23, 36, 71, 72, 74-79, 84.

Jacks teaches that it is well known in cosmetic art that isononyl isononanoate (non volatile hydrocarbon oil, MW 284.48 g/mole) is used to make lipstick compositions. See Example 2; instant claims 2-4. The reference also teaches using 10.34 % of diisoarachidyl dilinoleate (dispersant) in the lipstick formulation. See Example 2. See instant claims 11-19, 21-23, 36, 71, 72, 74-79, 84.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the lipstick composition of the combined references by substituting octyldodecyl neopentanoate and a diisoarachidyl dilinoleate with isononyl isononanoate as motivated by Jacks because the references are directed to lipstick formulations and Jacks teaches that these hydrocarbon oils are well known functional equivalents in lipstick art. The skilled artisan would have had a reasonable expectation of successfully producing a lipstick composition with similar effectiveness.

Claims 20 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mellul and Jacks as applied to claims 2-19, 21-27, 31-42, 44-51, 58, 62-72, 74-78, 81-95, 101- 102, 105, 106, 109-112 as above, and further in view of JP 63119412.

Mellul and Jacks, discussed above, do not teach poly(hydroxyl-12) stearic acid.

JP 63119412 abstract teaches 12-hydroxystearic acids is well known in lipstick art, and that the compositions having 12-hydroxystearic acid along with polyhydric

alcohol esters of rosin, fatty acids with polyhydric alcohol gives improved luster and good dispersion of color. See abstract.

It is generally considered prima facie obvious to combine two compounds each of which is taught by the prior art to be useful for the same purpose, in order to form a composition which is to be used for the very same purpose. The idea for combining them flows logically from their having been used individually in the prior art. See In re Kerkhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980). As shown by the recited teachings, the instant claims define nothing more than the concomitant use of conventional lipstick agents. It would follow that the recited claims define prima facie obvious subject matter.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have added 12-hydroxystearic acid to lipstick compositions of Mellul/Jacks as motivated by JP 63119412 because of the expectation of successfully producing a lipstick composition with improved luster and good dispersion of color, as taught by the Japanese abstract.

Response to Arguments

Applicant's arguments filed on July 18, 2008 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments regarding the previous rejection made in view of Brieve et al. (US 5800816) is withdrawn in view of applicant's remarks.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GINA C. YU whose telephone number is (571)272-8605. The examiner can normally be reached on Monday through Friday, from 9:00AM until 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gina C. Yu/
Primary Examiner, Art Unit 1611